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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/032,427	12/21/2001	Pekka Koponen	4208-4072	5709
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MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			ELALLAM, AHMED	
			ART UNIT	PAPER NUMBER
			2616	

DATE MAILED: 12/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/032,427

Applicant(s)

KOPONEN ET AL.

Examiner

AHMED ELALLAM

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application.
- ☐ Other: _____

DETAILED ACTION

This office action is responsive to RCE filed on 9/21/2006.

Claims 1-25 are pending.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1, 2, 4-6, 8, 9, 12, 13, 15 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Robinson et al, GB 2286505 A.

Regarding claim 1, with reference to figure 2, Robinson discloses a method for communicating information between a mobile station 16 (claimed first wireless communication device) and a radio communications system 10 (claimed communications network) via a transceiver gateway 14 (claimed particular second wireless communication device, the communications network being the second wireless communication device's own communications network), wherein the mobile station transmits a message to the gateway transceiver, the message comprising message identification, the address of the mobile station and authentication information that is provided to the gateway transceiver, see page 3, lines 17-27, lines 32-36 and page 4, lines 1-5, the gateway transceiver is empowered to pass information from the mobile station to the system controller (of the communication system) and from the controller system (of the communication network to the mobile station) when successful completion of message exchange is completed, see page 6, lines 9-16. (Claimed supplying user identification data of the first wireless communication device to the

second wireless communication device, and making a contact from the second wireless communication device to its own communications network using the user identification data of the first wireless communication device for communicating information between the first wireless communication device and the communications network via the second wireless communication device).

Regarding claim 2, Robinson with reference to figure 2 shows one single communication network in which the transceiver gateway is operable, and wherein the gateway is in the coverage area of the radio communication system, see page 8, lines 4-7. (Claimed second wireless communication device's own communications network is the closest communications network in which the second wireless communication device is arranged to operate).

Regarding claim 4, Robinson discloses that the coverage area 18 (figure 2) is much smaller than the coverage area of the radio communication system, see page 3, lines 14-16. Robinson further discloses extending the coverage area of the radio communication system, wherein the mobile station is outside of the coverage range of the communication system, and wherein the gateway is in close proximity to the mobile station, see page 7, line 33-36 and page 8, lines 1-6. (Claimed second wireless communication device is closer to the communications network than the first wireless communication device, and a connection between the second wireless communication device and the communications network is identified on the basis of data transmitted from a wireless communication device further away from the communications network).

Regarding claim 5, Robinson discloses having the mobile station transmits a

message to the transceiver gateway, the message comprising message identification, the address of the mobile station and authentication information is provided to the transceiver gateway, see page 3, lines 17-27, lines 32-36 and page 4, lines 1-5, and wherein the transceiver gateway transmit a third party registration message to the system controller of the communication system. See page 5, lines 1-5. (Claimed second wireless communication device establishes a connection to its own communications network on the basis of the user identification data of the first wireless communication device and on the initiative of the first wireless communication device).

Regarding claim 6, Robinson discloses that the mobile station communicate over a fixed radio channel to the gateway receiver, and then the gateway transceiver communicates to the system controller over a trunked communication channel, see page 3, lines 17-27. Robinson further discloses that the gateway transceiver indicate to the mobile station that the transceiver gateway is available to communicate to the system controller of the radio system, see page 4, lines 11-17, (Claimed second wireless communication device establishes a connection to its own communications network on behalf of the first wireless communication device).

Regarding claims 8 and 9, Robinson discloses that the connection between the mobile and the gateway transceiver is a fixed short-range connection, and the connection between the gateway transceiver and the network controller is long range radio communication channel, see page 3, lines 14-16, page 7, line 33-36 and page 8, lines 1-6. (Claimed transferring information between the first wireless communication device and the communications network via the second wireless communication device

in such a manner that: in the section between the first wireless communication device and the second wireless communication device, the information is communicated over a local link, and in the section between the second wireless communication device and the communications network, the information is communicated over a cellular network connection).

Regarding claims 12 and 13, Robinson discloses having the mobile station transmits a message to the transceiver gateway, the message comprising message identification, the address of the mobile station and authentication information that is provided to the transceiver gateway, see page 3, lines 17-27, lines 32-36 and page 4, lines 1-5, and wherein the transceiver gateway transmit a third party registration message to the system controller of the communication system based on the message received from the mobile station. See page 5, lines 1-5. In addition Robinson discloses that upon successful completion of message exchange, the gateway transceiver is empowered to pass information from the mobile station to the system controller and from the controller, see page 6, lines 9-16 (Claimed second wireless communication device registers to its own communications network using the user identification data of the first wireless communication device as in claim 12, and claimed second wireless communication device establishes a data transfer connection to its own communications network using the user identification data of the first wireless communication device for transferring information between the first wireless communication device and the communications network via the second wireless communication device, as in claim 13).

Regarding claims 15 and 16, with reference to figure 2, Robinson discloses a wireless mobile 16 (claimed wireless communication device) and gateway transceiver 14 (claimed second wireless communication device) and communication network 10 (claimed second communication device own network), wherein communicating information between the mobile station 16 and a radio communications system 10 is via a transceiver gateway 14, and wherein the mobile station transmits a message to the gateway transceiver, the message comprising message identification, the address of the mobile station and authentication information is provided to the gateway transceiver, see page 3, lines 17-27, lines 32-36 and page 4, lines 1-5, Robinson further discloses that the gateway transceiver is empowered to pass information from the mobile station to the system controller (of the communication system) and from the controller system to the mobile station when successful completion of message exchange is completed, see page 6, lines 9-16. (Examiner interpreted the mobile station of being the claimed means for supplying user identification data of the wireless communication device to the second wireless communication device), and means for causing the second wireless communication device to make a contact to the second wireless communication device's own communications network using the user identification data of the wireless communication device for communicating information between the wireless communication device and the communications network via said second wireless communication device as in claim 15; and claimed wireless communication device comprising means for supplying user identification data of the wireless communication device to second wireless communication device

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characterized in that the wireless communication device comprises means for causing second wireless communication device to make a contact to said second wireless communication device's own communications network using the user identification data of said wireless communication device for communicating information between the wireless communication device and communications network via said second wireless communication device).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 3 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson.

Regarding claim 3, Robinson discloses that the transceiver gateway operates in the trunked radio network. The difference between claim 3 and the teaching of Robinson is that Robinson doesn't specify that the radio network is a cellular network and the gateway transceiver is a cell device. However, cellular networks are widely known and use well established standards, it would have been obvious to a person of ordinary skill in the art, at the time the invention was made to apply the method of Robinson in cellular network since both trunked and cellular network use similar radio

communication protocols. The advantage would be the ability to extend the coverage range of the cellular communication system, (see Robinson, page 7, lines 33-35).

Regarding claim 14, the difference between claim 14 and the teaching of Robinson, is that Robinson does not specify the mobile device that communicates with the radio network is a PDA. However the use of PDA is widely known in wireless communication system. It would have been obvious to a person of ordinary skill in the art, at the time the invention was made to have the mobile devices of Robinson being PDA devices so that extended radio coverage for PDA can be provided as taught by Robinson..

3. Claims 7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson in view of Lee et al, US 2002/0101848. Hereinafter referred to as Lee.

Regarding claim 7 and 10, In addition to the short-range proximity of the mobile station to the gateway transceiver as discussed above with reference to claim 4, Robinson also discloses passing information from the system controller to the mobile station when communicating on behalf of the mobile station, see page 6, lines 12-16. (Claimed information content is distributed via the communications network and the second wireless communication device to the first wireless communication device and the information content is transmitted from the second wireless communication device to the wireless communication device over a short-range link).

The difference between the limitations of claim 7 and 10 and the teaching of Robinson is that Robinson doesn't specify that the information is content information

from a particular server of a particular service provider (as in claim 7) and the information is a communications network service (as in claim 10).

However, with reference to figure 5, Lee shows delivery of content information (communications network service as in claim 10) from particular content servers (150 and 130) of particular service provider via a wireless gateway 40 to a wireless device 10 (as in claim 7).

It would have been obvious to a person of ordinary skill in the art, at the time the invention was made to make the information transmitted via the gateway transceiver to the mobile of Robinson being content information from a particular server of a particular service provider as taught by Lee so that the system of Robinson can be used to access the Internet. The advantage would be the ability to use Robinson's gateway transceivers extendable range in having access to the Internet of Robinson subscribers.

4. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson in view of Lager et al, US (6,636,502).

Regarding claim 11, Robinson, as discussed above with reference to claim 1, discloses that the mobile station transmits a message to the gateway transceiver, the message comprising message identification, the address of the mobile station and authentication information to the gateway transceiver, but does not specify an IMSI as part of the identification information.

However, Lager discloses a Mobile station having an IMSI (International Mobile Station Identity) for use in a registration process. See column 3, lines 9-25.

It would have been obvious to a person of ordinary skill in the art, at the time the invention was made to have the registration message sent to the gateway transceiver of Robinson using an IMSI code as indicated by Lager so that the invention of Robinson can be applied to mobiles in conformance with GSM standard that uses SIP cards.

5. Claims 17-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson in view of Findikli et al, US (6,445,914).

Regarding claim 17, 20 and 23, Robinson, as discussed above with reference to respective parent claims 1, 15 and 16, discloses the mobile station transmits a message to the gateway transceiver, the message comprising message identification, the address of the mobile station and authentication information to the gateway transceiver, but does not specify the identification information comprises an operator identifier.

However, Findikli discloses a Mobile station having an IMSI for use in a registration process, the IMSI contains a mobile network code (MNC) that identify the cellular operator. See column 3, lines 18-28.

It would have been obvious to a person of ordinary skill in the art, at the time the invention was made to have the registration message sent to the gateway transceiver of Robinson using an IMSI code comprising conventional mobile network code MNC as indicated by Findikli so that the invention of Robinson can be applied to mobiles in conformance with GSM standard that uses SIP cards.

Regarding claims 18, 21 and 24, the limitations of these claims are interpreted based on the specification to mean that the wireless device have a SIM (Subscriber

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Identifier Module). Robinson does not disclose having a SIM attached to the mobile station.

However, Findikli discloses mobile stations using SIM cards for registration process. It would have been obvious to a person of ordinary skill in the art, at the time the invention was made to use the SIP cards technology of Findikli in the registration of mobile units so that the invention of Robinson can be applied to mobile unite that belong to GSM standards.

Regarding claims 19, 22 and 25, the limitations of these claims is understood based on the specification to mean that the wireless device registers using the SIM via the second wireless device to a network operated by the same operator of the SIM.

Robinson does not disclose this feature, However, Findikli discloses having the operator of both the SIM and the network identified by the SIM. See abstract. (Claimed wireless device registers using the SIM via the second wireless device to a network operated by the same operator of the SIM).

Therefore it would have been obvious to a person of ordinary skill in the art, at the time the invention was made to implement the coverage range extension method of Robinson applied to mobile units using SIP cards so that GSM cellular networks take advantage of the coverage range that Robinson provides. (Robinson, page 7, lines 33-35).

Response to Arguments

6. Applicant's arguments filed on 9/21/2006 have been fully considered but they are not persuasive:

Claim Rejections under 35 USC § 102:

Applicants argue that Robinson et al, GB 2286505 A does not anticipate the invention of claim 1. Applicants argue that Robinson doesn't teach the required limitation "*supplying user identification data of said first wireless communication device to said second wireless communication device*" (hereinafter referred to as first limitation), further Applicants argue that Robinson also doesn't teach "*making a contact from said second wireless communication device to its own communications network using the user identification data of said first wireless communication device*" (hereinafter referred to as second limitation). Italics added.

As to the first limitation, Applicants argue that the "message" of Robinson is not the same as the "user identification data" because "*The specification of the instant application makes clear that "user identification data" is information that identifies the user of a mobile device rather than the mobile device itself. (See, e.g., Application, p.8, lines 21- 24)*" Emphasis added. Applicants further argue that "*neither the mobile station address, the message identification, nor the authentication information of the search message of Robinson are "user identification data"*", because "*the mobile station address of the search message in Robinson clearly identifies a mobile device rather than a user*", A "*message identification*" in Robinson also is not "*user identification*

data" because it identifies a message, such as a search message, an acknowledgement message or the like, rather than a user." Emphasis added.

Examiner respectfully disagrees, the passage in the specification relating to the user identification data for identifying the user is provided below for convenience (specification page 8, lines 21-29):

"Let us also assume that the user of the mobile station has inserted into the mobile station the user data identification module 26 (SIM card) which contains the user identification data of the mobile station. The user identification data is used to identify the user. The mobile station 20 now typically displays a message in the user interface UI (e.g. display unit) requesting the user to enter his or her own personal identity code, i.e. a PIN code. The user enters the PIN code and, assuming it was the correct one, the mobile station 20 registers to the network 30 according to prior art technology using the user identification data of the SIM card 26 for authentication. After this, the user of the mobile station 20 can, as necessary, establish a connection to the network 30 for initiating a data connection or voice call".

Robinson discloses that the mobile station transmits a message to the gateway transceiver, the message comprising message identification, the address of the mobile station and authentication information that is provided to the gateway transceiver, see page 3, lines 17-27, lines 32-36 and page 4, lines 1-5.

Given the passage above from the specification, the argued "user identification data" is described as **"user identification data of the mobile station"** for identifying

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the user. Nevertheless, the user is required to enter his or her own personal identity code, wherein the mobile station registers to the network according to **prior art technology** using the user identification data of the SIM card for authentication.

Examiner notes that the terminal identification address of Robinson is an identification of the mobile station, this address with authentication information in the message of Robinson is clearly an information that identify the user as well as the mobile station in use. Furthermore, as the specification admits registration of the mobile station to the network by using user identification (of the SIM card) for authentication is **a prior art technology**. It is apparent that, in addition to the first limitation being taught by the prior art, the claim limitation can be also interpreted of being taught by Robinson, because of the authentication step in the message along the address of the terminal that are supplied to the transceiver gateway (Claimed supplying user identification data of said first wireless communication device said second communication device). In addition, Robinson discloses authenticating the gateway transceiver as a proper gateway transceiver for the mobile station 1 using the message. Thus the level of security may be imposed on the communication system". See Robinson, Page 4, lines 2-5 and lines 17-23. Examiner further notes that the features upon which Applicants rely upon "the user identification data for specifying the user are not recited in the rejected claim 1. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Therefore, given the broadest reasonable interpretation of the claimed first limitation, the interpretation of Robinson is proper.

As to the second limitation, *"making a contact from said second wireless communication device to its own communications network using the user identification data of said first wireless communication device"*. Applicants argue that *"in Robinson, the authentication information sent from mobile station 16 to transceiver 14 is not used to contact the system controller of the trunked radio system of Robinson; rather, it is used only to authenticate transceiver 14 as a valid transceiver. If after transceiver 14 has been validated, mobile station 16 decides to employ transceiver 14 as a gateway to the radio system, transceiver 14 does not use the authentication information originally transmitted to it by mobile station 16 to make contact with the radio system. Instead, it uses the device address of mobile station 16"*.

Examiner respectfully disagrees, Robinson discloses *"The gateway transceiver search message contains a message identification, an address of the direct mode mobile station 16, and, optionally, authentication information to authenticate the gateway transceiver 14 as a valid gateway transceiver"* (page 4, lines 2-5), and *"The gateway transceiver 14 receives the gateway transceiver search message and responds to the mobile station 16 by transmitting a gateway transceiver acknowledgement message 22 to the mobile station 16. The gateway transceiver acknowledgement message indicates to the mobile station 16 that the gateway transceiver 14 is available to communicate to the system controller 12 of the trunked radio system for the mobile station 16. The gateway transceiver acknowledgement*

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message contains a message identification, the address of the gateway transceiver 14, the address of the direct mode mobile station 16 and, optionally, the gateway transceiver authentication information. The gateway transceiver authentication information authenticates the gateway transceiver 14 as a proper gateway transceiver for the mobile station 16. Thus, a level of security may be imposed on the communications system". Page 4, lines 11-23. From the above Robinson passages, the message sent having authentication information to the gateway is processed by the gateway to instruct the mobile terminal that is a valid gateway, that is the message (user identification data) from the mobile terminal is used by the gateway to provide contact between the mobile station 16 and radio communications system 10 through the gateway. Therefore, the message of Robinson (i.e. "user identification data" as broadly interpreted as indicated above with regard to the first limitation) and contrary to Applicants allegations, is used to provide contact between the gateway and the radio communication network using the message from the mobile unit.

Dependent claims:

Applicants did not address the rejections of the dependent claims believing that Robinson does not anticipate independent claims. Examiner disagrees for the reasons stated above. Dependent claims are believed to be properly rejected given the anticipation of independent claims 1, 15, and 16.

Claims 15, 16 contain similar limitations as in claim 1, therefore they are not allowable over Robinson for similar reasons indicated with regard to claim 1.

Examiner believes, given the most reasonable broadest interpretation of the claim limitations, the prior art used is maintained as being proper.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to AHMED ELALLAM whose telephone number is (571) 272-3097. The examiner can normally be reached on 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, To Doris can be reached on (571) 272-7629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AHMED ELALLAM
Examiner
Art Unit 2616
12/8/06



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